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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Kazuki Matsui

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02/09/2006

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EXAMINER

FISCHETTI, JOSEPH A

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/955,049

Applicant(s)

MATSUI ET AL.

Examiner

Joseph A. Fischetti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 5-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

Newly submitted claims 16-18 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: re claims 17 and 18 are drawn to the nonelected network specified in Group VII in the restriction dated 5/17/05; re claim 16 drawn to the nonelected computer terminal specified in Group VI in the restriction dated 5/17/05.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 16-18 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Revashetti in view of Haven.

The preamble successfully integrates the items recited into the body of the claim. Thus, the recitation of "search parameters" in the preamble is read as the "key" that matches

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the pattern specified by the product signature col. 11, 48-57 and thus is deemed sufficiently integrated with the body of the claim to constitute a limitation. Accordingly, Revashetti discloses an information presentation device 210 in which a user terminal on a network 208 that retrieves products or services comprising:

accepting means for accepting a selection of a product or service that is included in said products or services that were retrieved (is read as the active host program which goes into the client computer 208 to accept the product data on the HD of the computer 208); and parameter storage means for storing the search parameters for the selected product or service as a candidate for purchase (read as inventory database 212 which through detection software detects a product on the client computer), together with user identification information that identifies said user terminal (analysis is particular to a given computer col. 6 lines 61-63 and hence inherently must include identification of the client computer 208).

Regarding the limitation of retrieving "products based on the search parameters designated by the user", applicant is directed to col. 7 line 6 in which the client computer is scanned to retrieve products which are listed on the client computer. Notwithstanding, Haven discloses using search parameters to devise paths to product/services desired by the user. It would be obvious to modify Revashetti et al. to use the search parameters on the hard drive rather than the product themselves, the motivation being the more broader information ascertainable from the parameters than the items.

Claim 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Revashetti et al. in view Havens as applied above and further in view of Welsh et al. Revashetti et al. and Havens disclose the invention substantially as claimed as set forth above with respect to claim 2, but not with respect to the limitations of claims 3 and 4. However, Welsh et al. does disclose does disclose user request accepting means for accepting user reference requests from first group of computer terminals on said network (predictive content system 700 and expert 1206 accepts by monitoring reference requests e.g. click stream decisions); Welsh et al. further disclose user reference request parameter providing means for extracting from said parameter storage means a first user identification information identifying said first user terminals that have selected a first product as a candidate for purchase that is provided by an administrator of a provider terminal included in said first computer terminals (PID associates a user with a subset of content categories, content manager matches content choices with the PID see col. 13), and search parameters that each of said first user terminals has set to said first product, and providing them to said provider terminal (based on this association, content system 700 presents a selection of content choices to the user col. 8, 62 et seq.) Welsh et al. further disclose information setting means (PID database 1104 col. 12 line 39) for receiving from said provider terminal the designation of user identification information included in said first user identification information provided to said provider terminal, and product information settings for said designated user identification information (PID obviously includes settings of product information in order to be mapped to see col. 8 line 52); product information storage

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means for storing said designated user identification information (read as the PIDI data base which also receives the PID data where I indexes a profile), and presentation means (read also as the content system 700 which presents a selection of content choices to the user) for receiving a purchase candidate reference request from a designated user terminal identified by said designated user identification information. Regarding the extracting device portion of claim 4, the identifier PIDI is referenced to a product information set and the user it reads on the extraction functions and these users identified by the suffix I are or can be presented as a group given the old and notorious use of a sorting function in computers. It would be obvious to modify the system of Revashetti et al with the grouping feature of Welsh et al. as described above, the motivation being the ability to categorized groups of users or people who like a certain product for ease in mass marketing.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

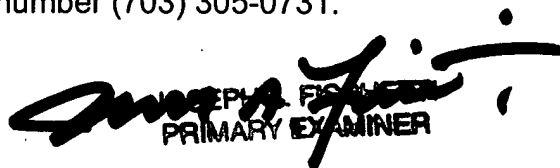
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication should be directed to PRIMARY EXAMINER Joseph A. Fischetti at telephone number (703) 305-0731.


JOSEPH A. FISCHETTI
PRIMARY EXAMINER